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<p>PATENT APPLICATION</p>  <p>10749631</p>

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In re Application of :
Heniz-Werner Kleemen et al : Decision on Petition
Serial No.: 10/749,631 :
Filed : 31 December 2003 :
Attorney Docket No.: DEAV2002/0094 :

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 13 December 2006 requesting withdrawal of a restriction requirement. The delay in acting upon this petition is regretted.

BACKGROUND AND DISCUSSION

A review of the file history shows that this application was filed under 35 U.S.C 111(a) on 31 December 2003, and contained claims 1-48. In a first Office action, mailed 25 October 2005, the examiner set forth a restriction requirement as follows:

Group I, claims 1-6, 20 and 33, drawn to products of Formula I
Group II, claims 7-19, 21-32 and 34-47 drawn to methods of using the products of Formula I and
Group III, claim 48, drawn to a process of preparing the products of Formula I.

The examiner also required an election of species within whichever group was elected. The examiner also advised applicants of possible rejoinder of product and process claims.

On November 22, 2005, applicants elected Group I and a species without traverse.

The petition filed 13 December 2006 states that the election was made on 22 November 2005 with traverse. This is incorrect. The election was made without traverse. On 22 November 2005, Applicants did not specifically and distinctly point out errors in the restriction requirement.

MPEP 818.03(c) states that applicants must traverse to preserve right of petition, citing 37 CFR 1.144, set forth below.

37 CFR 1.144. Petition from requirement for restriction.

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

If upon election, applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.02. In the Office action mailed 22 February 2006, the examiner did just that. The examiner clearly stated that the election was made without traverse. However, in the interest of compact prosecution, this petition will be considered even though applicants did not traverse upon election.

MPEP 803.02 provides guidance concerning the examination practice for Markush-type claims.

...Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration....

At the onset, the examiner followed this guidance. In the non-final Office action mailed 22 February 2006, the examiner concluded that the elected species would be allowable, if written as independent claim. The examiner also extended the search and examination to non-elected species and applied prior art under 35 USC 103(a) and made an obvious-type double patenting rejection.

With these two rejections, the Markush-type claim was found to be not allowable. It was appropriate then that the provisional election was given effect and further search and examination was not conducted.

The petition argues that in the first Office action on the merits, the examiner should have extended the search to one of the non-elected species of quinaline, isoquinaline or quazoline. However, this is not persuasive. Once an elected species is found allowable, the examiner (not applicant) is entitled to select any second or subsequent species encompassed by the Markush-type for further search and examination. In response to a rejection, Applicants may help guide the examination process by removing non-patentable species from their Markush claim by amendment.

The petition then requests that the finality of the Office action mailed 8 September 2006 should be removed. In this argument, applicants are correct. In the first Office action on the merits, the examiner made the rejection under 35 USC 103(a) on a non-elected species (as appropriate for examination practice set forth in MPEP 803.02) but then withdrew the rejection as being improper because it was directed to non-elected species. The rejection under 35 USC 103(a) was not withdrawn because of an amendment by applicant to remove non-elected subject matter from

the claims. Because the examiner did not make and/or maintain a sustainable obviousness rejection, the Office actions are considered incomplete and finality is considered premature. The search and examination practice for the Markush-type claims should have been followed in a second non-final action on the merits. Instead, the examiner made the second Office action final, even though there was no rejection on a second or subsequent species encompassed by the Markush-type claim. The only outstanding rejection in the final Office action was made provisionally under obviousness-type double patenting. The applicants have responded to this rejection by filing a terminal disclaimer. For these reasons, the finality of the last Office action has been withdrawn.

DECISION

Accordingly, although the election was made without traverse, the petition filed under 37 CFR 1.144 has been considered on the merits and is **GRANTED-IN-PART**.

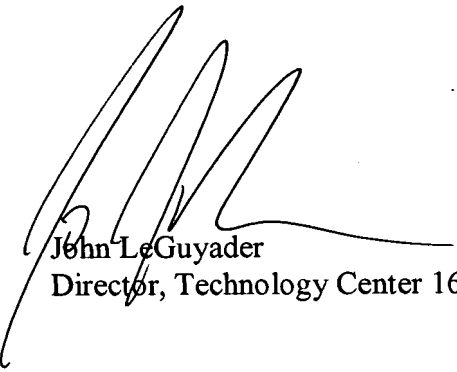
The restriction requirement and provisional election of species is proper. The Markush-type claims will be examined according to MPEP 803.02.

The finality of the Office action mailed 8 September 2006 has been withdrawn.

The application will be forwarded to the Examiner for consideration of the papers filed 5 March 2007 and for preparation of a non-final Office action following the examination practice set forth in MPEP 803.02.

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.



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